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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,047	06/11/2001	Akira Oomori	35.G2819	2412

5514 7590 08/09/2006

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EXAMINER	
LEE, TOMMY D	
ART UNIT	**PAPER NUMBER**
2625	

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/877,047	OOMORI, AKIRA	
	Examiner	Art Unit	
	Thomas D. Lee	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *31-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/15/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 30, 2006 has been entered.

Response to Amendment

2. This Office action is responsive to applicant's amendment filed June 30, 2006. Claims 31-58 are pending.

Response to Arguments

3. Applicant's arguments filed in the amendment of June 30, 2006, at pages19 and 20, in response to the rejections of claims 31-40 under either 35 U.S.C. 102(b) or 103(a) as set forth in the prior Office action, have been fully considered but they are not persuasive.

Applicant's response is based on the claims *as amended to overcome the prior rejections*. The rejections of the amended claims and newly added claims are set forth below.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 35, 36, 38, 40, 44-46, 50-52 and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,392,131 (Umeno) in view of U.S. Patent 5,361,143 (Nakayama et al., hereinafter Nakayama).

Regarding claims 35 and 44, Umeno discloses an image transmission apparatus for displaying names of or images representing a plurality of files at least one of which contains image data of a document image and for enabling the manual selection one of the plurality of files, whose name or image is displayed, for transmission, comprising: a memory adapted to store each of the plurality of files including that at least one file containing the document image so that the document image is stored as image data (image memory stores image data of an original document to be transmitted (column 3, lines 34-37)); a display unit configured to display the plurality of names of or the plurality of images representing the plurality of files stored in said memory (display on which data of an original document to be retrieved is displayed (column 3, lines 8-10); plurality of document data retrieved and displayed (column 8, lines 32-37)); a file selection unit adapted for a user to select at least one of the plurality of files in said memory whose name or image is displayed on said display unit (touch panel used to select document for transmission (column 8, lines 49-53)); and a transmitting unit adapted to transmit the image data to the destination apparatus (communication processor calls destination party designated, and transmission of associated document carried out (column 7, lines 50-64)). Said file selection unit comprises a touch panel comprising a document transmission screen comprising said display unit (touch panel (column 8, lines 49-53)).

Umeno does not disclose a controller adapted to read out the data in a format suitable for a destination apparatus, from a file which was selected by a user through said file selection unit, wherein in the event the selected file is the file containing image data of the document image, the controller reads out the image data of the document in a format suitable for a destination apparatus, as recited in claim 35. However, as mentioned in the prior Office action, Nakayama discloses an image transmitting apparatus, wherein when the destination is capable of multi-color printing, integrated data and data of each color are transmitted (column 4, line 67 – column 5, line 3); otherwise, either only integrated data or monochrome data are transmitted (column 5, lines 21-28). By determining the capability of the destination apparatus prior to transmission of a document, the apparatus is able to transmit the document with greater efficiency in the case where the destination is found to be incapable of multi-color printing, while enabling faithful reproduction of a multi-color image at a destination capable of multi-color printing.

Regarding claim 36, Nakayama discloses storage of the document image both as color image data and monochrome image data in the file (column 4, lines 40-48).

Regarding claim 45, Umeno in view of Nakayama does not explicitly disclose the display of a storage-box reference button group comprising a plurality of differently labeled storage buttons each representing a different one of the plurality of files, wherein each storage button is labeled with the name of one of the plurality of files, wherein one of the files is selected for transmission in response to the user touching one of the displayed buttons; and an in-box document field comprising one or more

names of the one or more documents stored in the files represented by the plurality of buttons, wherein a document of a file is selected for transmission in response to the user touching the name of that document and touching the button of the file to which that document belongs. Umeno does provide a touch panel for selecting one or more documents, as mentioned above. The touch panel is not described in detail, so one cannot say for sure whether each button of the touch panel corresponds to a respective document. However, it is well known in the art to provide a panel with numerous keys, wherein the selection of a particular key enables access to a corresponding piece of information stored in memory. For example, in facsimile communications, it is well known to store plural destination fax numbers in memory, and to access a desired destination by pressing a single key on the touch panel. Likewise, it is well known in the art to access a stored document by pressing a corresponding key. It would have been obvious for one of ordinary skill in the art to provide such a feature in Umeno, for it enables the access of a desired document by pressing a single key, thereby saving time and effort.

Regarding claim 46, Umeno further discloses the display of a transmission destination input field into which the user inputs a transmission destination to which the image data from one of the document images will be transmitted in response to a selection of the user (designation dial number entered through operation of numeral keys (column 4, lines 31-36), entered dial number displayed (Fig. 5)); and transmission start button, the pressing of which by the user starts transmission of the selected file and document (start key operated in order to start transmission (column 7, lines 33-45)).

Umeno in view of Nakayama does not explicitly disclose a destination type selection button group comprising a plurality of buttons each representing a different type of transmission destination, wherein the input of the transmission destination is confirmed in response to the user touching one of the buttons of the destination type selection button group; and a transmission destination field into which the input transmission destination is registered in response confirmation of the input destination by the user touching one of the buttons of the destination type selection button group. However, as mentioned above with regard to claim 45, it is well known to store plural destination fax numbers in memory, and to access a desired destination by pressing a single key on the touch panel. It would have been obvious for one of ordinary skill in the art to provide such a feature in Umeno, for it enables the access of a desired destination by pressing a single key as opposed to a plurality of keys necessary for inputting a destination fax number, thereby saving time and effort.

Claims 38 and 50-52 are method claims corresponding to above-rejected apparatus claims 35 and 44-46, respectively. The method steps are performed by the combined teaching of Umeno and Nakayama, as set forth above.

Claims 40 and 56-58 recite a program storage medium storing a program for performing the steps of above-rejected claims 38 and 50-52, respectively. While the combined teaching of Umeno and Nakayama does not disclose a program storage medium, it is generally well known to one of ordinary skill in the art that processing steps are commonly stored as a program in a memory disk, or the like, to be read by a central processing unit of an apparatus, and it would have been obvious to provide a

program storage medium in the combined teaching of Umeno and Nakayama, so as to enable the apparatus to perform the processing steps.

6. Claims 31-34, 37, 39, 41-43, 47-49 and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,666,211 (Tahara et al., hereinafter Tahara) in view of Nakayama.

Regarding claim 31, Tahara discloses an image processing apparatus for enabling manual designation of an image-data storage destination prior to transmission of image data from the storage destination comprising: an image reading unit adapted to read a document image (document reader optically scans document image (column 4, lines 38-53)); a manually controlled input unit that designates a storage destination in a memory of image data corresponding to the document image read by said image reading unit in response to an instruction by a user (transmission data storage designation switch designates storage of image in optical disk cassette (column 5, lines 52-57)); and a file creating unit adapted to create a file in the memory at the manually designated destination into which the image data corresponding to the document image will be stored, and from which the image data will be transmitted in response to an instruction by a user (image compressed data for transmission stored in a portion of the memory of the optical disk cassette (column 7, lines 60-65)).

Tahara does not disclose a controller adapted to register the document image which was read by said image reading unit both as color image and as monochrome image data in the file which was created by said file creating unit at the manually designated destination. This limitation is disclosed in Nakayama (in multi-color mode,

black (monochrome) data and color data read and stored (column 4, lines 26-48); in monochrome mode, only black data read and stored (column 4, lines 49-55)). By storing a document image as both a color image and as a monochrome image, the apparatus is able to transmit the document with greater efficiency in the case where the destination is found to be incapable of multi-color printing, while enabling faithful reproduction of a multi-color image at a destination capable of multi-color printing.

Regarding claims 32-34, the image processing apparatus disclosed in Nakayama further comprises a transmission unit adapted to transmit image data to a destination apparatus, wherein said controller reads out one of the color image data to a destination apparatus, wherein said controller reads out one of the color image data and the monochrome image data stored in the file, which is suitable for the destination apparatus, and controls said transmission unit to transmit the read out image data to the destination apparatus (when other party is capable of multi-color printing, integrated data and data of each color transmitted (column 4, line 67 – column 5, line 3); otherwise, either only integrated data or monochrome data are transmitted (column 5, lines 21-28)); and a determining unit adapted to determine whether a document is one of a color document and a monochrome document (in automatic color selection mode, color contained in original identified through prescanning (column 4, lines 11-19)), wherein, when said determining unit determines that the document is a color document, said controller registers the document image both as the color image data and as the monochrome image data in the file, and when said determining unit determines that the document is a monochrome document, said controller registers the document image as

the monochrome image data in the file (storage of both types when multi-color mode is judged (column 4, lines 26- 48); storage of monochrome data in monochromatic mode (column 4, lines 49-55)). Said image reading unit continuously reads image data for a plurality of documents (continuous scanning and storage until last page is reached (column 4, lines 56-61)).

Regarding claim 41, Tahara, as mentioned above, discloses a transmission data storage designation switch for designating a storage destination. While a touch panel comprising an image storage screen displaying a plurality of storage destinations is not disclosed, it is well known in the art to provide such a panel with keys on a liquid crystal display, wherein the selection of a particular key enables access to a corresponding piece of information stored in memory. It would have been obvious for one of ordinary skill in the art to provide such a feature in Tahara as an alternative to the designation switch, because of its well-known use in the art.

Regarding claim 42, Tahara in view of Nakayama does not explicitly disclose the display of a storage-box reference button group comprising a group of buttons each representing a different file at a different storage destination in said memory for the image data corresponding to the document image read by said image reading unit, wherein one of the files at one of the storage destinations in said memory is selected in response to the user touching of the buttons; and a destination field comprising the storage box or storage boxes selected by the user by the user touching one of the buttons in said storage-box selection button group. However, as mentioned above, it is well known in the art to provide a panel with numerous keys, wherein the selection of a

particular key enables access to a corresponding piece of information stored in memory, and to place the information in a display field. It would have been obvious for one of ordinary skill in the art to provide such a feature in Tahara, for it enables the access of a desired storage destination by pressing a single key, thereby saving time and effort.

Regarding claim 43, Nakayama discloses permitting a user to designate a scanning mode, and reading the document image in the scanning mode selected by the user (column 4, lines 20-39). In combination with Tahara, the document image which was read by said image reading unit is registered in the file at the optical disk cassette which was selected by the user touching the transmission data storage designation switch, as mentioned above.

Claims 37 and 47-49 are method claims corresponding to above-rejected apparatus claims 31 and 41-43, respectively. The method steps are performed by the combined teaching of Tahara and Nakayama, as set forth above.

Claims 39 and 53-55 recite a program storage medium storing a program for performing the steps of above-rejected claims 37 and 47-49, respectively. While the combined teaching of Tahara and Nakayama does not disclose a program storage medium, it is generally well known to one of ordinary skill in the art that processing steps are commonly stored as a program in a memory disk, or the like, to be read by a central processing unit of an apparatus, and it would have been obvious to provide a program storage medium in the combined teaching of Tahara and Nakayama, so as to enable the apparatus to perform the processing steps.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday, 7:30-5:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas D Lee
Primary Examiner
Technology Division 2625

tdl
August 4, 2006